

REMARKS/ARGUMENTS

Amendments in General

1. Claims 1-7 of the application as filed have been canceled.
2. Claim 8 has been amended to include the specific limitation that the first magnet is a neodymium magnet.
3. New Claim 11 has been added to the application.
4. None of these amendments add any new matter to the application and acceptance of these claims is respectfully requested.

Claim Rejections - 35 USC § 102

5. The Examiner rejected claims 1 and 3 under §102(b) as being anticipated by Galler U.S. Pat. No. 6,035,449.
6. Claims 1 and 3 have been canceled from the application.

Claim Rejections - 35 USC § 103

7. The Examiner rejected claims 2,4, and 5 under §103(a) as being unpatentable (obvious) in view of Galler in view of Marbacher.
8. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).
9. In this case the combination suggested by the Examiner fails to meet these criteria, and Applicant respectfully submits that the Examiner’s rejection should be withdrawn.

10. The Galler and the Marbacher references have significantly different structures and significantly different purposes. There is no motivation to combine these references and even if combined, these references would not teach all of the features of the present invention.

11. The Galler reference teaches the combination of two flat bar magnets encased within pieces of material so as to form a backless pocket. These pieces can be separated and placed on opposing sides of an article of clothing. The purpose of this device is to provide a pocket that will remain in place upon an article of clothing and will neither slide from the clothing nor will it mar or damage the clothing.

12. The Marbacher reference teaches a magnetic buckle and clasp that interlock and which includes a cam and a recess into which the cam will slip. This device is distinct and different from the prior art devices such as the Galler reference because the Galler reference does not include this cam and recessed feature. The Galler reference teaches away from the Marbacher reference because the Marbacher reference teaches a device that would mar or possibly even cut the clothing that would be placed between the magnetized portions of the device.

13. Furthermore the Galler reference teaches covering the magnetic portions of the device in that reference. The Marbacher device teaches that the magnetic portions must be configured so as to allow the various portions to fit within compatibly configured recesses. Covering the magnet in the Galler reference would not allow the magnetized portion to fit within the designated recess. This would impede and destroy the functionality of the Marbacher reference.

14. Thus, Applicant submitted that neither Galler nor Marbacher teach or even suggest Applicant's claimed invention, and, indeed these references teach away from Applicant's invention. *See In re Gurley*, 27 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994). Applicant submits, therefore, that one skilled in the art would not be motivated to modify Galler to include the features of Marbacher or vice versa.

15. From these two references it is clear that there is no motivation to combine their teachings.

16. Even if these devices are combined these references do not teach the presence of all of the features of the present invention.

17. Claim 8 claims a shoulder strap retaining device configured to assist in retaining a shoulder strap or other similar device in a desired position upon a person.

18. Neither of the references cited by the Examiner describe a shoulder strap retaining device for maintaining a shoulder strap in a desired location upon the shoulder of a wearer. The

Galler reference describes a removable pocket and the Marbacker device describes a buckle for connecting two ends of a strap or belt together. There is no teaching in either of these references no is there a teaching in the combination of the references to produce a device configured to hold a shoulder strap on the body of a wearer of the device.

19. Claim 8 requires the inclusion of a first neodymium magnet encased within a padded container said first magnet and said padded container configured to be placed against a person's skin.

20. Neither the Galler reference nor the Marbacker device include this feature, nor do they teach this feature. There is no suggestion or motivation or explicit teaching to modify the structures in the Galler or Marbacker reference so as to arrive at these features claimed in the present invention.

21. While the Examiner has indicated that the use of a neodymium magnet is merely a design choice the law requires that there be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

22. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicant's specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

To drawn on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references “must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention.” *Akzo N.V. v. United States Int’l Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

23. Galler and Marbacker are complete and functional without the need for modification. Absent the need for modification to provide functionality, the references could never lead one to make modifications to meet the claims.

24. Moreover, the motivating suggestion must also be **explicit**. An invention cannot be found obvious unless there is “some **explicit** teaching or suggestion in art to motivate one of even ordinary skill to combine such elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998).

25. The present invention also requires a second magnet having a projecting adornment attached thereto. The second magnet configured for placement over the outer portion of an individual’s clothes. The second magnet and the first magnet further configured to mutually attract one to another and to hold and maintain the second magnet in a desired position and orientation upon the shoulder of the person utilizing the device. The second magnet forming a projection extending from the article of clothing. The second magnet configured to maintain the shoulder strap in a desired position and location.

26. The references cited by the Examiner fail to include all of these features. Neither of these references teach the inclusion of a second magnet with a projecting adornment attached to it. Furthermore, neither of these references teach the inclusion of a second magnet with a projecting adornment which is configured to hold a purse upon the body of wearer. Similarly neither of these devices teach the intercombination or connection of any of these devices with another device in such a way so as to hold a device in a desired position upon a wearer.

27. In as much as the references cited by the Examiner, are not properly combinable and fail to teach all of the claimed features of the present invention, Applicant respectfully requests that the Examiner accept these amendments, consider these remarks, and pass the amended claims in the application on for allowance.


Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 16th day of February, 2005

Respectfully Submitted,



DEREK H. MAUGHAN
Reg. No. 52,007
Phone 208-345-1122